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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,492	01/06/2006	Sophie Duquesne	REGIM 3.3-057	2459
530 7590 12/08/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER SANDERS, KRIELLION ANTIONETTE	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,492

Applicant(s)

DUQUESNE ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

Applicant's Terminal Disclaimers are effective to overcome the rejections over U.S.

Patent No.7,288,588 and copending Application No. 11/517,623.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 11-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7 and 9-13 of U.S. Patent No. U.S. Patent No.7,105,605. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

2. The present invention relates to a copolymer for use in or as a polymeric binder for an intumescent coating comprising: a blend of a Newtonian copolymer and a reticulated copolymer,

wherein said blend of Newtonian copolymer and reticulated copolymers includes at least one substituted styrene and at least one substituted acrylate comprising p-methylstyrene and 2-ethylhexylacrylate.

3. The patented invention is directed to a copolymer composition for use in or as a polymeric binder in an intumescent coating, said copolymer composition comprising a blend of a Newtonian copolymer and of a reticulated copolymer, wherein the Newtonian copolymer is comprised of p-methylstyrene repeat units and 2-ethylhexylacrylate repeat units, and wherein the reticulated copolymer is comprised of p-methylstyrene repeat units and 2-ethylhexylacrylate repeat units.

The Newtonian copolymer may be the same as that of the patented invention, The reticulated copolymer may be the same as that of the patented invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al US Patent No. 3,733,289 in view of Korper US Patent No. 5,964,931. This rejection is repeated for reasons of record.

At page 5, lines 13 – 23 of applicant's specification applicant states that:

The examples of suitable Newtonian copolymers include Pliolite VTAC-L, Pliolite VTAC-H, Plioway ECH, Plioway Ultra 200, Plioway ECI, all trademarks from 20 ELIOKEM. The examples of suitable reticulated copolymers include Pliolite AC3H, Plioway ECL, Plioway Ultra G20, Plioway EC-T, all trademarks from ELIOKEM.

Burns et al discloses a method of making an intumescent composition that may comprise the vinyl resins of applicant's invention, (such as Pliolite VTAC TM or pliolite VTAC-L TM). The compositions may further include chlorinated paraffin, a carbon forming substance, a foam-forming substance of polyphosphoric acid and an ammonium salt of phosphoric acid. The reference also discloses the inclusion of other conventional additives for intumescent coatings as set forth in the working examples. The components of the patented compositions are mixed together to form the resulting coating compositions. See col. 2, lines 44-57, col. 3, lines 39-73, claims 11, 13 and 17-18.

Korper discloses a method for producing a coating composition that may comprise a primary resin, (such as Plioway Ultra 200 TM), disclosed by applicant as being a suitable Newtonian resin; and a secondary resin, (such as Plioway Ultra G20 TM), which is disclosed by applicant as being a suitable reticulated resin at page 5 of the specification. See Korper at col. 6, lines 45-50, See col. 7, line 2. Therefore, the reference discloses the presently claimed blends. Also see column 6, line 46 et seq. The reference also discloses the inclusion of other conventional additives as well as process steps that correspond to the present claims. See column 7, line 25 to column 8, line 19.

Both references teach the manufacture of a coating composition. Burns et al discloses that the resins employed, are identical to those of applicant's claims and those of the Korper document. Burns et al also teaches that the resulting compositions possess intumescent characteristics. The production steps set out by Korper are conventional. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the resins disclosed by either reference in the manufacture of a coating composition, in the manner taught by the references, following the guidelines set forth therein. Burns would provide guidance for formulating an intumescent composition utilizing the components of the patent. Applicant has shown nothing of an unexpected nature by following the directions of the patented disclosures.

Response to Arguments

2. Applicant's arguments filed 8/25/08 have been fully considered but they are not persuasive. Applicant argues that the secondary reference to Korper is non-analogous art and is not properly combinable with Burns et al. This argument is not persuasive because Korper discloses a method for producing a coating composition that may comprise a primary resin, (such as Plioway Ultra 200 TM), disclosed by applicant as being a suitable Newtonian resin; and a secondary resin, (such as Plioway Ultra G20 TM), which is disclosed by applicant as being a suitable reticulated resin at page 5 of the specification. See Korper at col. 6, lines 45-50, See col. 7, line 2. Therefore, the Korper reference by itself discloses applicant's presently claimed blends. Korper does not disclose the compositions to be intumescent, however the components and their inherent functions may not be separated. Applicant has essentially claimed a new use for an old product. In response to applicant's argument that the Korper reference is nonanalogous art, it has been held that a prior art reference must either be in the field of

applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Korper compositions are in effect a type of coating composition in that they are compositions used in markers.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kriellion A. Sanders/
Primary Examiner, Art Unit 1796

Kriellion A. Sanders
Primary Examiner
Art Unit 1796

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